

REMARKS

Claims 1-8 are pending. By this Amendment, claims 1-3 and 6-8 are amended for better clarity, without being narrowed by such amendments. No new matter is added. Reconsideration of the application is respectfully requested.

Entry of the amendments is proper under 37 CFR §1.116 since the amendments: (a) place the application in condition for allowance (for the reasons discussed herein); (b) do not raise any new issue requiring further search and/or consideration (since the amendments amplify issues previously discussed throughout prosecution); (c) satisfy a requirement of form asserted in the previous Office Action; (d) do not present any additional claims without canceling a corresponding number of finally rejected claims; and (e) place the application in better form for appeal, should an appeal be necessary. The amendments are necessary and were not earlier presented because they are made in response to arguments raised in the final rejection. Entry of the amendments is thus respectfully requested.

Applicants appreciate the courtesies shown to Applicants' representatives by Examiners Tran and Bashore in the April 11 personal interview. Applicants' separate record of the substance of the interview is incorporated into the following remarks. During the interview, the §112 rejections were discussed. The Examiner suggested further amendments to better clarify the claim language.

The Office Action rejects claims 1, 2 and 3 under 35 U.S.C. §112, second paragraph.

With respect the claims 1 and 2, the Office Action states that the term "more similar" renders the claims indefinite. However, as discussed during the interview, Applicants respectfully submit that the term is used for comparison. That is, claim 1, for example, recites that at least a portion of a first version is more similar in visual appearance to a corresponding portion of a thumbnail than to a corresponding portion of the original

document based on comparison of the at least a portion of the first version to the corresponding portion of the original document and the corresponding portion of the thumbnail. In other words, the portion of the first version may be similar to both the thumbnail and the original document. However, claim 1 recites that the first version is more similar to the thumbnail. As discussed during the interview, the comparison may be quantitative or qualitative, but not specifying how the comparison is made does not render claims 1 and 2 indefinite.

Claim 2 is amended to add the phrase "than to the corresponding portion of the first version." As such, Applicants respectfully submit that claims 1 and 2 are clear and would be understood by one of ordinary skill in the art without further clarification.

In addition, during the interview, the Examiners stated that the term "appearance" may be considered indefinite. Claims 1, 2, 6 and 7 are amended to recite "visual appearance," for the sake of clarity, without narrowing the claims. Applicants respectfully submit that because a thumbnail is a visual representation of an original document, the first version is also "visually" similar to a corresponding portion of the thumbnail.

As to claim 3, the Office Action states that the term "substantially" renders the claim indefinite. Applicants respectfully disagree. As described in paragraph [0099] of the specification, the second version of the original document that is more similar to the original document may actually be identical to the original document 7. In other words, as discussed during the interview, the second version may contain minor differences from the original document but generally is the same as the original document. Applicants respectfully assert that, from the description in the specification, one of ordinary skill in the art would understand the meaning of the term "substantially." See MPEP §2173.05(b). As such, Applicants respectfully submit that no further clarification of claim 3 is necessary.

Claim 3 is amended for clarity only. Claim 8 is also amended to be consistent with claim 3. It is respectfully submitted that claims 3 and 8 are not narrowed by such amendments.

In view of the foregoing, withdrawal of the rejection under 35 U.S.C. §112 is respectfully requested.

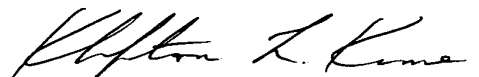
The Office Action rejects claims 1-8 under 35 U.S.C. §103(a) over U.S. Patent Application Publication No. 2002/0135621 A1 to Angiulo et al. (hereafter "Angiulo") in view of U.S. Patent No. 6,751,620 B2 to Orbanes et al. This rejection is respectfully traversed.

Applicants respectfully submit that Angiulo is not valid prior art under 35 U.S.C. §103(a). That is, as established by the attached Declaration Under 37 C.F.R. §1.131 signed by the inventors of this application, the inventors invented the subject matter of the present application prior to the March 20, 2001 filing date of Angiulo. The claimed subject matter is fully supported by the invention proposal entitled "Enhanced Thumbnail of Documents" attached to the Declaration. Accordingly, Applicants respectfully request withdrawal of this rejection.

In view of the foregoing, it is respectfully submitted that this application is in condition for allowance. Favorable reconsideration and prompt allowance of claims 1-8 are earnestly solicited.

Should the Examiner believe that anything further would be desirable in order to place this application in even better condition for allowance, the Examiner is invited to contact the undersigned at the telephone number set forth below.

Respectfully submitted,



James A. Oliff
Registration No. 27,075

Klifton L. Kime
Registration No. 42,733

JAO:KLK/mdw

Attachments:

Declaration Under 37 C.F.R. §1.131
Exhibit A

Date: April 12, 2005

OLIFF & BERRIDGE, PLC
P.O. Box 19928
Alexandria, Virginia 22320
Telephone: (703) 836-6400

<p>DEPOSIT ACCOUNT USE AUTHORIZATION Please grant any extension necessary for entry; Charge any fee due to our Deposit Account No. 24-0037</p>
--